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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,830	12/03/2001	Taiyuu Miyamoto	027260-504	7164

7590 03/27/2006
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EXAMINER

RIZZUTO, KEVIN P

ART UNIT PAPER NUMBER

2183

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/998,830

Applicant(s)

MIYAMOTO, TAIYUU

Examiner

Kevin P. Rizzuto

Art Unit

2183

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2, 5, 6 and 8.
Claim(s) withdrawn from consideration: 3, 4 and 7.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Applicant argues in substance that:

“Applicant respectfully traverses the Examiner’s statement that storing user data on a non-volatile memory in addition to enable code is an obvious variation. Sibigtroth et al. merely discloses storing a state of an enable signal. The Examiner goes on to state that reconfigurable non-volatile memories are well known in the art. Applicants respectfully submit that this issue is not whether the invention can be modified in the light of the prior art. Rather, patentability hinges upon whether there is any teaching to modify the prior art to arrive at the claimed invention. Nothing in Sibigtroth et al. shows, teaches or suggests storing anything other than an enable signal. Nothing in the Official Notice shows, teaches or suggests why it would be obvious to modify Sibigtroth et al. to store anything other than an enable signal and in particular store user data and one of a lock code, function-selecting code or limiting code as claimed in claims 1, 5 and 6. Applicant respectfully submits that there is no teaching in either Sibigtroth et al. or the Official Notice which would lead a person of ordinary skill in the art to store user data and one of a lock code, function-selecting code or limiting code as claimed in claims 1, 5 and 6.”

This argument is not found persuasive for the following reasons:

To begin, the limitation in question, that is, “said memory has a reprogrammable nonvolatile memory *storing user data*” includes functional language in an apparatus claim. Such limitations do not further define a structure so as to differentiate the apparatus from an apparatus of the prior art. See MPEP 2114 [R-1] Apparatus and Article Claims — Functional Language.

To summarize, Applicant is arguing that storing one extra piece of data in a non-volatile memory (claimed as “user data”), which is a broad term since all data stored has an inherent user associated with it, is a non-obvious variation of Sibigtroth. The sole difference between the claimed memory and the memory disclosed by Sibigtroth is that the claimed memory requires extra “user data”, which is never applied or used anywhere else in the claims, it is only required that “user data” is stored in the non-volatile memory.

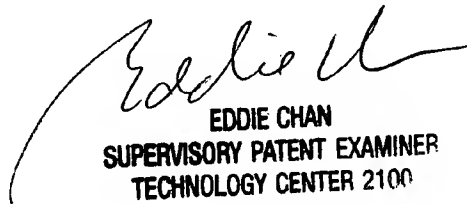
Applicant argues that, “nothing in Sibigtroth et al. shows, teaches or suggests storing anything other than an enable signal.” Examiner agrees with this statement, however, Examiner also notes that there is no teaching in Sibigtroth that precludes additional information from being stored in the nonvolatile memory.

Applicant also argues that, “the Examiner goes on to state that reconfigurable non-volatile memories are well known in the art.” However, Applicant’s statement that “the Examiner goes on to state that reconfigurable non-volatile memories are well known in the art” is misleading in that the Examiner’s Official Notice did not merely state that non-volatile memories are well known, it stated that it is well known in the art for non-volatile memories to store multiple types and instances of important data that needs to be saved even after power is removed from the system.”

Applicant further argues that, “nothing in the Official Notice shows, teaches or suggests why it would be obvious to modify Sibigtroth et al. to store anything other than an enable signal and in particular store user data and one of a lock code, function-selecting code or limiting code as claimed in claims 1, 5 and 6.” However, the Official Notice stated,

"Examiner takes Official Notice that reconfigurable nonvolatile memories are well known in the art to store multiple types and instances of important data that needs to be saved even after power is removed from the system." Storing additional information in the non-volatile memory has the inherent benefit of being able to retain additional information, which could be used for any of a multitude of purposes, and being able to retain the additional information after power is removed, thus allowing the storage of important information and must be kept despite power removal. Therefore, the Official Notice has provided motivation to store additional information in the non-volatile memory.

In conclusion, the limitation in question is merely requiring that additional information ("user data") be stored in a memory, which Examiner has shown to be an obvious variation over the prior art. The "user data" is not further mentioned in the claims. Further clarification as to the how the user data affects/interacts with the structure, if supported by the specification as required by 35 U.S.C. 112, 1st paragraph, may cause the claim to overcome the applied prior art.


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